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# Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Application No. Applicant(s) 09/598,793 TARBOURIECH, PHILIPPE Office Action Summary Examiner Art Unit CARL COLIN 2136 -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS. WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status 1) Responsive to communication(s) filed on 15 January 2008. 2a) This action is FINAL. 2b) This action is non-final. 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Claims 4) Claim(s) 1-30 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. 5) Claim(s) \_\_\_\_\_ is/are allowed. 6) Claim(s) 1-30 is/are rejected. 7) Claim(s) \_\_\_\_\_ is/are objected to. 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement. Application Papers 9) The specification is objected to by the Examiner. 10) The drawing(s) filed on is/are; a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abevance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner, Note the attached Office Action or form PTO-152. Priority under 35 U.S.C. § 119 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) ☐ All b) ☐ Some \* c) ☐ None of: Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). \* See the attached detailed Office action for a list of the certified copies not received. Attachment(s) 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)

Notice of Draftsperson's Patent Drawing Review (PTO-948)

Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/(wait Date see attached.

Paper No(s)/Mail Date.

6) Other:

5) Notice of Informal Patent Application

Application/Control Number: 09/598,793 Page 2

Art Unit: 2136

### DETAILED ACTION

#### Continued Examination Under 37 CFR 1.114

 A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/15/2008 has been entered.

#### Response to Arguments

- 2. In response to communications filed on 1/15/2008, applicant amends claims 1, 6, 11, 15, 18, 19, 21, 23-25, and 28, claim1 remains objected as explained in the objection below, the rejection was not directed to the fingerprint, but "the values". The 112th rejection of the claims has been withdrawn with respect to the amendment. The following claims 1-30 are presented for examination.
- 2.1 Applicant's arguments filed on 1/15/2008 have been fully considered but they are not fully persuasive as amended. Applicant argues that the prior art does not disclose "the circuit being disposed on a silicon die and comprising two or more devices formed on the silicon die for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the silicon die

was manufactured" as amended. However, previously cited art Lofstrom discloses this limitation and the rejection of the claims is set forth below.

#### Information Disclosure Statement

 The information disclosure statement filed on 1/15/2008 and 3/8/2008 has been considered by the Examiner.

### Claim Objections

 Claim 1 and the intervening claims are objected to because in step (d), the phrase "the fingerprinting values" the fingerprinting value. Appropriate correction is required.

## Claim Rejections - 35 USC § 112

- The following is a quotation of the second paragraph of 35 U.S.C. 112:
   The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 5.1 Claims 14, 18-22, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- 5.2 Claims 14 and 18-22 recite limitations referring to subsections that were not previously disclosed in the claims they are dependent of. For instance, claim 14 recites step (d) and claim 11 has a step (d); claim 18 is referring to steps (d) and (f) of claim 15; claim 19 is referring to step (e) of claim 15; claim 20 is referring to step (g); claim 21 depends on claim 15, and starts

with step (e). Claim 24 recites "said sections" it is not clear which sections the claim is referring to and further disclosed selecting "the" index identification... There is insufficient antecedent basis for these limitations in the claims.

### Claim Rejections - 35 USC § 103

- The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,381,346 to Eraslan in view of US Patent 6,161,213 to Lofstrom.

As per claim 11, Eraslan discloses a method for resolving an identification, said method comprising the steps of (a) receiving a digital fingerprint (see claim 1) and further discloses the fingerprint corresponds to characteristics of a circuit (i.e. the imaging system or the computer system (see column 15, lines 43-47 and column 15, lines 5-18); (b) dividing the digital fingerprint into at least two sections, the sections comprising a series of bits (see columns 13-14

Art Unit: 2136

and claim 1); (c) storing the sections in association with an index identification in a database (see columns 13-14 and claim 1); and (d) repeating steps (a) - (c) a desired number of times (see columns 13-14 and claim 1). Eraslan does not explicitly disclose the circuit being disposed on a silicon die and comprising two or more devices formed on the silicon die for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the silicon die was manufactured. Lofstrom in an analogous art teaches a circuit being disposed on a silicon die and comprising two or more devices formed on the silicon die for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the silicon die was manufactured (see column 2, lines 50-65; column 4, line 58 through column 5, line 45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eraslan to provide a circuit wherein the fingerprint is based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the silicon die was manufactured as taught by Lofstrom. This modification would have been obvious because one of ordinary skill in the art would have some of the advantages disclosed by Lofstrom (see column 4, lines 10-21).

As per claim 12, Eraslan discloses the limitation of wherein said storing step (c) comprises the steps of storing each section in a separate table in association with the index identification (see figure 33 and see column 4, lines 18-32; column 12; column 13, lines 28-32); see also column 9, lines 18-20).

Art Unit: 2136

As per claims 13, 17, 27, and 30, Eraslan discloses the limitation of wherein separate database servers support each table (see figure 33).

As per claim 14, Eraslan discloses the limitation of (d) receiving a digital fingerprint (see claim 1); (e) dividing the digital fingerprint into at least two sections, said sections comprising a series of bits (see columns 13-14 and claim 1; see also column 12, lines 28-42); (f) scanning the database for sections stored in step (e) that match the sections of step (e) (see column 14, lines 3-13 and column 15, lines 34-48); (g) selecting the index identification associated with a statistically sufficient number of matching sections (see column 9, lines 7-12; column 14, lines 3-13 and column 15, lines 34-48).

As per claim 15, Eraslan discloses a method for identifying a digital fingerprint corresponding to an integrated circuit from a database including a population of fingerprints, the method comprising the steps of (a) receiving a digital fingerprint (see claim 1); (b) scanning for sections of the fingerprints stored in the database that match corresponding sections of the fingerprint received in step (a) (see column 15, lines 34-48); (c) selecting the fingerprint stored in the database associated with a statistically sufficient number of matching sections (see column 14, lines 3-13; column 10, lines 27-35 and claim 17). Eraslan is silent as to the circuit comprising two or more devices formed on the integrated circuit for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the integrated circuit due to a process by which the integrated circuit was manufactured. Lofstrom in an analogous art teaches a circuit being disposed on a silicon die

Art Unit: 2136

and comprising two or more devices formed on the silicon die for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the silicon die was manufactured (see column 2, lines 50-65; column 4, line 58 through column 5, line 45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Eraslan** to provide a circuit wherein the fingerprint is based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the integrated circuit was manufactured as taught by **Lofstrom**. This modification would have been obvious because one of ordinary skill in the art would have some of the advantages disclosed by **Lofstrom** (see column 4, lines 10-21).

As per claim 28, Eraslan discloses an apparatus for identifying a digital fingerprint comprising a fingerprint section database, the database including digital fingerprints comprising a series of sections stored in association with an index identification (see column 15, lines 34-48); a server operably coupled to the fingerprint section database (see column 11, lines 21-30 and lines 50-57) wherein the server receives a digital fingerprint and scans the fingerprint associated with a statistically sufficient number of sections that match corresponding sections of the received digital fingerprints (see column 12, lines 50-60 and column 14, lines 3-13); (see also column 10, lines 27-35 and claim 17). Eraslan is silent as to the circuit comprising two or more devices formed on the integrated circuit for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the integrated circuit due to a process by which the integrated circuit was manufactured. Lofstrom in an

Art Unit: 2136

analogous art teaches a circuit being disposed on a silicon die and comprising two or more devices formed on the silicon die for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the silicon die was manufactured (see column 2, lines 50-65; column 4, line 58 through column 5, line 45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Eraslan** to provide a circuit wherein the fingerprint is based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the integrated circuit was manufactured as taught by **Lofstrom**. This modification would have been obvious because one of ordinary skill in the art would have some of the advantages disclosed by **Lofstrom** (see column 4, lines 10-21).

As per claim 18, Eraslan discloses dividing codes in sections and storing the stability value of the least stable bit in each section in association with a section identifier and the most probable digital fingerprint (see column 13, lines 25 through column 14; see column 14, lines 44-47 and column 9, line 57 through column 10, line 21).

As per claim 19, Eraslan discloses the limitation of (g) transmitting at least two section identifiers and corresponding sections of the most probable digital fingerprint, the sections having the highest stability values calculated in step (e) (see column 4, lines 59-67 and column 9, line 57 through column 10, line 35).

Art Unit: 2136

As per claim 20, Eraslan discloses the limitation of wherein the number of sections transmitted in step (g) is statistically sufficient to find a matching digital fingerprint (see column 4, lines 45-58 and column 9, line 57 through column 10, line 35).

As per claims 16, 26, and 29, Eraslan discloses the limitation of wherein the database comprises at least two section tables each of which stores a separate section of the fingerprints in association with a corresponding index identification (see columns 13-14 and claim 1); and wherein the scanning step (b) comprises scanning the section tables with corresponding sections of the digital fingerprint received in step (a) (see column 15, lines 34-48).

As per claim 21, Eraslan discloses (e) receiving a digital fingerprint, the digital fingerprint comprising at least two sections, wherein the sections comprise a series of bits (see columns 13-14 and claim 1); (f) receiving section identifiers and corresponding stability values for each section of the digital fingerprint (see column 4, lines 59-67 and column 9, line 57 through column 10, line 21); (g) using the sections having the highest stability values, scanning the database to locate matching sections (see column 10, lines 22-35); and (h) selecting the index identification associated with a statistically sufficient number of matching sections (see column 4, lines 45-58 and column 9, line 57 through column 10, line 35).

As per claim 22, Eraslan discloses the limitation of (i) if no index identification corresponds to a statistically sufficient number of matching sections, scanning the database for all sections stored in step (c) that match the sections received in step (e) (see column 9. lines 7-

Art Unit: 2136

17 and column 5, lines 5-10); and (j) selecting the index identification associated with a statistically sufficient number of matching sections (see column 4, lines 45-58 and column 9, line 57 through column 10, line 35).

Claim 23 recites the same limitations found in claim 21 and claim 15. Therefore, claim 23 is rejected based on the same rationale as the rejection of claims 22 and 15.

As per claim 24, Eraslan discloses the limitation of (e) receiving at least two section identifiers and corresponding sections of a digital fingerprint, said sections comprising a series of bits (see column 4, lines 59-67); (f) scanning the database to find sections stored in step (c) that match sections received in step (e) (see column 9, lines 35-56); and (g) selecting the index identification associated with a statistically sufficient number of matching sections (see column 4, lines 45-58 and column 9, line 57 through column 10, line 35).

As per claim 25, Eraslan discloses a method for identifying a digital fingerprint from a database including a population of fingerprints, the method comprising the steps of (a) receiving at least two section identifiers and corresponding sections of a digital fingerprint, said sections comprising a series of bits (see column 4, lines 59-67); (b) scanning the database to find sections of the stored fingerprints corresponding to the section identifiers received in step (a) that match the sections received in step (a) (see column 9, lines 35-54); and (c) selecting the fingerprint associated with a statistically sufficient number of matching sections (see column 4, lines 45-58 and column 9, line 57 through column 10, line 35). Eraslan is silent as to the circuit comprising

Art Unit: 2136

two or more devices formed on the integrated circuit for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the integrated circuit due to a process by which the integrated circuit was manufactured. **Lofstrom** in an analogous art teaches a circuit being disposed on a silicon die and comprising two or more devices formed on the silicon die for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the silicon die was manufactured (see column 2, lines 50-65; column 4, line 58 through column 5, line 45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Eraslan** to provide a circuit wherein the fingerprint is based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the integrated circuit was manufactured as taught by **Lofstrom**. This modification would have been obvious because one of ordinary skill in the art would have some of the advantages disclosed by **Lofstrom** (see column 4, lines 10-21).

Claims 1-4, 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US
Patent 6,026,193 to Rhoads in view of US Patent 6,058238 to Ng in view of US Patent
6,161,213 to Lofstrom.

As per claim 1, Rhoads discloses a method for resolving the most probable digital fingerprint from a circuit (see figure 5), the circuit outputting a digital fingerprint comprising a series of bits, the method comprising the steps of (a) polling the circuit for a digital fingerprint (see column 7); (b) recording the digital fingerprint (see column 7); (c) repeating steps (a) and

Art Unit: 2136

(b) a desired number of times to result in a fingerprinting value for a corresponding iteration of said polling and recording (see column 7); and (d) calculating the most probable digital fingerprint from the values yielded in steps (a) - (c) (see column 7, see also columns 3-4). Rhoads suggests restarting the encoding process, i.e. resetting the noise source to repeat the sequence just produced in order to generate a unique code number that could be interpreted as polling the circuit at power up for a digital fingerprint (column 21, line 59 through column 22, line 3). Ng in an analogous art teaches polling a circuit at power up each time for a new identifier in order to create a resetting period so that a unique recorder identifier (fingerprint) is generated (see column 7, lines 14-34). This provides control for recording to only a particular recorder (see column 2, lines 26-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Rhoads to generate a device identifier at power up so that the chances of having two devices with the same identifier is very negligible (one out of 16 million) as taught by Ng. This modification would have been obvious because one of ordinary skill in the art would have been motivated by the suggestions provided by Ng so as to provide control for recording to only a particular recorder (see column 2, lines 26-30). Rhoads does not explicitly disclose the circuit being disposed on a silicon die and comprising two or more devices formed on the silicon die for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the silicon die was manufactured. Lofstrom in an analogous art teaches a circuit being disposed on a silicon die and comprising two or more devices formed on the silicon die for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the circuit due to a

Art Unit: 2136

process by which the silicon die was manufactured (see column 2, lines 50-65; column 4, line 58 through column 5, line 45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Rhoads** to provide a circuit wherein the fingerprint is based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the silicon die was manufactured as taught by **Lofstrom**. This modification would have been obvious because one of ordinary skill in the art would have some of the advantages disclosed by **Lofstrom** (see column 4, lines 10-21).

As per claim 2, Rhoads discloses the limitation of (e) storing the most probable digital fingerprint (see column 5, lines 13-15).

As per claim 3, Rhoads discloses the limitation of (e) calculating the stability value of at least one bit in said digital fingerprint (see column 16, lines 13-51).

As per claim 4, Rhoads discloses the limitation of (f) storing the most probable digital fingerprint in association with the stability value calculated in step (e) (see column 16, lines 18-48; see also column 17, lines 25-37).

As per claim 6, Rhoads discloses the limitation of an apparatus providing a digital fingerprint comprising a digital fingerprint circuit, said digital fingerprint circuit outputting a digital fingerprint comprising a plurality of bits (see figures 5-6); a control circuit, said control circuit operably connected to the digital fingerprint circuit and programmed to iteratively read

Art Unit: 2136

the digital fingerprint a predetermined number of times (see column 9); and wherein the control circuit calculates the most probable digital fingerprint based on the iterative reads of the digital fingerprint circuit (see column 9). Rhoads also discloses that the technique can be applied to a variety of technology including piracy and authentication, for instance, as fingerprint associated with scanning of a personal card (see fig. 25). "It is clear that wherever a material exists which is capable of being modulated by `noiselike' signals, that material is an appropriate carrier for unique identification codes and utilization of the principles of the invention." Rhoads further discloses an embodiment using a black box system as a real time encoder (figure 5). Ng in an analogous art teaches polling a circuit at power up each time for a new identifier in order to create a resetting period so that a unique recorder identifier (fingerprint) is generated (see column 7, lines 14-34). This provides control for recording to only a particular recorder (see column 2, lines 26-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Rhoads to generate device identifier corresponding to electrical characteristics of a plurality of devices so that the chances of having two devices with the same identifier is very negligible (one out of 16 million) as taught by Ng. This modification would have been obvious because one of ordinary skill in the art would have been motivated by the suggestions provided by Ng so as to provide control for recording to only a particular device(see column 2, lines 26-30). Eraslan does not explicitly disclose the circuit being disposed on a silicon die and comprising two or more devices formed on the silicon die for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the circuit due

Art Unit: 2136

to a process by which the silicon die was manufactured. **Lofstrom** in an analogous art teaches a circuit being disposed on a silicon die and comprising two or more devices formed on the silicon die for a digital fingerprint, the digital fingerprint being based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the silicon die was manufactured (see column 2, lines 50-65; column 4, line 58 through column 5, line 45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Eraslan** to provide a circuit wherein the fingerprint is based at least in part on an electrical characteristic of the two or more devices of the circuit due to a process by which the silicon die was manufactured as taught by **Lofstrom**. This modification would have been obvious because one of ordinary skill in the art would have some of the advantages disclosed by **Lofstrom** (see column 4, lines 10-21).

As per claim 7, Rhoads discloses the limitation of further comprising a memory operably connected to the control circuit wherein the control circuit stores the most probable digital fingerprint in the memory (see figure 6).

As per claim 8, Rhoads discloses the limitation of wherein the control circuit calculates a stability value for at least one bit of the digital fingerprint based on the iterative reads of the digital fingerprint circuit (see column 9 and column 16, lines 13-51).

Art Unit: 2136

8. Claims 5, 9, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,026,193 to Rhoads in view of US Patent 6,058238 to Ng in view of US Patent 6,161,213 to Lofstrom as applied to claims 1-4, 6-8 and further in view of US Patent 6,381,346 to Eraslan.

As per claims 5 and 9, Rhoads substantially discloses calculating the stability value of each bit in said digital fingerprint (see column 16, lines 13-51; see also columns 21-22). Rhoads further discloses storing the stability value of the least stable bit in association with the most probable digital fingerprint (see column 16, lines 18-48; see also column 17, lines 25-37; see also column 23). Rhoads does not explicitly teach storing for each section, the stability value of the least stable bit in each section in association with a section identifier and the most probable digital fingerprint calculated in step (d). However, Eraslan in an analogous art teaches dividing codes in sections and storing the stability value of the least stable bit in each section in association with a section identifier and the most probable digital fingerprint (see column 13, lines 25 through column 14; see column 14, lines 44-47). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Rhoads to divide each section with stability value associated with section identifier and most probable fingerprint to provide a fast search engine as taught by Eraslan. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by Eraslan so as to provide a fast search engine for large collection of data (see column 3, lines 1-8).

As per claim 10, Rhoads discloses the limitation of further comprising means for transmitting the digital fingerprint and the stability values stored in the memory (see column 16, lines 40-60).

#### Conclusion

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to CARL COLIN whose telephone number is (571)272-3862. The
examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl Colin/ Primary Examiner, Art Unit 2136 September 19, 2008